

## RESPONSE AND REMARKS

### **CLAIM REJECTIONS UNDER 35 USC SECTION 103(a)**

In the Office Action, Claims 1-6, 49-52 and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nicholls et al. (U.S. Patent No. 5,485,369; "Nicholls") in view of Fisher et al. (U.S. Patent No. 6,047,264; "Fisher"), Kara et al. (U.S. Patent No. 6,233,568; "Kara") and Thiel (U.S. Patent No. 5,699,258; "Thiel"). Claims 28-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nicholls in view of Pauley et al. (U.S. Patent No. 4,958,280; "Pauley"), Kara and Thiel.

Claims 1-6, 28-33, 49-52 and 58 may sometimes be referred to herein collectively, as the "rejected Claims".

### **RESPONSIVE REMARKS REGARDING CLAIM REJECTIONS UNDER SECTION 103(a)**

The rejections of the Claims have been carefully considered. Independent Claims 1, 28, 49 and 50 have been amended.

For the reasons given below, it is respectfully submitted that none of Nicholls, Fisher, Thiel, Pauly, and Kara, whether considered alone, or in combination, anticipate, disclose, teach or suggest all of the limitations of the Claims, as amended, of the present application.

#### **A. The Asserted Combination of Fisher With Nicholls Is Not Supported and Therefore Does Not Meet the Requirements of MPEP §706.02(j) and MPEP §2143**

For the following reasons and authorities, Applicants respectfully disagree that the Office Action presents a proper foundation for combining Fisher with Nicholls. More specifically, it is respectfully asserted that there is an insufficient foundation for rejection of Claims 1-6, 49-52 and 58 as required under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

First, it is respectfully asserted that the assertions made in the Office

Action regarding the rejection of Claims 1-6, 49-52 and 58 in view of Nicholls and Fisher do not reflect the limitations recited by Claims 1-6, 49-52 and 58. For example, the Office Action states that “Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A) ....” Office Action, Topic No. 8, p. 3.

Applicants respectfully disagree that the statement in the Office Action that “Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A) ....” (Office Action, Topic No. 8, p. 3) fully reflects the limitations of the rejected Claims, including Claims 1-6, 49-52 and 58. For example, Claim 1 recites the limitations that “...for each respective carrier of the plurality of carriers *that would provide electronic mail delivery notification* for shipping the particular parcel according to the request, display ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.” (Emphasis added).

As compared to the above-recited limitations of Claim 1, it is respectfully submitted that none of the cited references, including Nicholls, disclose any variation in carrier-support of Proof of Delivery. That is, it is respectfully submitted that none of the cited references, including Nicholls, disclose that some carriers may provide Proof of Delivery and that some carriers may not. Rather, it is respectfully asserted that it appears that the cited references, including Nicholls, assume that all carriers provide Proof of Delivery. It is respectfully asserted that it appears that if a user, in addition to entering other shipping information, designated the “Proof of Delivery” option in the Nicholls FIG. 4A, the Nicholls system would calculate a rate that would include any charge by a carrier for the requested “Proof of Delivery” option. However, it is respectfully submitted that there is no disclosure in Nicholls, that the Nicholls system would test whether a carrier would, or would not, provide the “Proof of Delivery” option.

As compared to the apparent assumption by Nicholls that all carriers provide the “Proof of Delivery” service, the Specification of the present

application explains:

One of the problems in dealing with standalone Carrier systems is that, if the Shipper wants electronic mail ("e-mail") notification that a particular parcel has been delivered, the Shipper must attempt to apply each Carrier's rules for providing a Shipper with electronic mail notification that a particular parcel has been delivered. Each Carrier's electronic mail delivery notification pricing rules must be separately applied by the Shipper to shipment of a particular parcel to determine *whether or not the particular Carrier offers electronic mail delivery notification and if so, the price for the service.*

Specification, p. 2, lines 19-25. It is respectfully asserted that, for example, Claim 1 recites limitations that reflect the above-mentioned disclosure of the specification. More specifically, for example, Claim 1 recites the limitations "...for each respective carrier of the plurality of carriers *that would provide electronic mail delivery notification* for shipping the particular parcel according to the request, ...." (Emphasis added).

Even so, independent Claims 1, 49 and 50 have been amended to more distinctly recite a determination of whether each carrier provides the relevant type of delivery notification service option. For example, Claim 1 has been amended to recite the limitation "...for each respective carrier of a plurality of carriers, determine whether the respective carrier would provide electronic mail delivery notification for shipping the particular parcel according to the request ...." Similarly, Claim 49 has been amended to recite the limitation "...for each respective carrier of a plurality of carriers, determine whether the respective carrier would provide each of the plurality of delivery notification service options for shipping the particular parcel according to the request ...." Similarly, Claim 50 has been amended to recite the limitation "...for each respective carrier of a plurality of carriers, for each respective delivery notification service option of the at least one delivery notification service options, determine whether the respective carrier would provide the respective delivery notification service option for shipping the particular parcel according to the request ...."

The Office Action further states that "Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of

Delivery (See Figure 4A), but fails to disclose the specific delivery requirements includes an electronic mail delivery notification.” Office Action, Topic No. 8, p. 3. In order to compensate for the above-quoted statement that “Nicholls ... fails to disclose the specific delivery requirements includes an electronic mail delivery notification ...,” the Office Action states that “Fisher discloses a method for supplying automatic status updates using e-mail (See abstract) ...” and asserts that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as disclosed by Fisher ....” Office Action, Topic No. 8, p. 3. The Office Action further asserts that the aforementioned combination “... would have been obvious ... in order to automatically send delivery status messages over email without the aid or need of a human customer service representative [citing Fisher, cols. 1 and 2].” Office Action, Topic No. 8, p. 3.

As opposed to the above-quoted assertions of the Office Action regarding Nicholls and Fisher repeated mention of a carrier’s “specific delivery requirements,” it is respectfully submitted that none of Claims 1-6, 49-52 and 58 recite any limitation regarding a carrier’s “delivery requirements.” Rather, Claim 1, for example, recites “...receive ... a request input by a user for an electronic mail delivery notification service by a carrier system for shipping a particular parcel ...” Claim 1, for example, further recites “... for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, display ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.”

Further, as opposed to the above-quoted statement in the Office Action that “Fisher discloses a method for supplying automatic status updates using e-mail ...,” it is respectfully submitted that the limitations claimed by Claims 1-6, 49-52 and 58 are not directed to supplying, or in any way providing, automatic status updates using email. Rather, Claim 1, for example, recites limitations to

"...receive ... a request input by a user for an electronic mail delivery notification service by a carrier system for shipping a particular parcel ..." and then, "... for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, display ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications."

For the foregoing reasons and authorities, it is respectfully asserted that the combination of Fisher with Nicholls asserted in the Office Action is based on an improper foundation that fails to accurately reflect the claimed limitations of Claims 1-6, 49-52 and 58. Accordingly, it is respectfully asserted that there is an insufficient foundation for rejection of Claims 1-6, 49-52 and 58 as required under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

Yet further, for the following reasons and authorities, it is respectfully asserted that the Office Action offers no evidence to support the asserted combination of Nicholls and Fisher. It is therefore respectfully asserted that the Office Action provides insufficient evidence of the asserted obviousness to make the asserted combination of Nicholls and Fisher.

The Office Action states that "Nicholls ... fails to disclose the specific delivery requirements includes an electronic mail delivery notification ...," but posits that "Fisher discloses a method for supplying automatic status updates using e-mail (See abstract) ...," and then follows with the conclusion that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as disclosed by Fisher ...." Office Action, Topic No. 8, p. 3. Citing Fisher itself, the Office Action further asserts that the aforementioned combination "... would have been obvious ... in order to automatically send delivery status messages over email without the aid or need of a human customer service representative [citing Fisher, cols. 1 and 2]." Office Action, Topic No. 8, p. 3.

For the following reasons and authorities, it is respectfully asserted that the Office Action's citation to Fisher alone provides insufficient basis to combine a feature of Fisher posited by the Office Action with Nicholls.

First, as compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination "... in order to automatically send delivery status messages over email ...," it is respectfully submitted that none of Claims 1-6, 49-52 and 58 are directed to supplying, or in any way providing, automatic status updates using email. Rather, Claim 1, for example, recites the limitations to "...receive ... a request input by a user for an electronic mail delivery notification service by a carrier system for shipping a particular parcel ..." and then, "... for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, display ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications."

Yet further, as compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination "... in order to automatically send delivery status messages over email ...," it is respectfully submitted that Nicholls does not disclose "... automatically send[ing] delivery status messages over email ...."

Further still, as compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination "... in order to automatically send delivery status messages over email ...," it is respectfully submitted that there is no disclosure in Fisher of the Fisher carriers themselves providing any type of delivery notification. Rather, in Fisher, as further explained below, the Fisher system interrogates a carrier's system to determine the status of a customer's respective shipment; the Fisher system then composes an email message to the respective customer regarding the status of the customer's respective shipment.

Yet further, it is respectfully asserted that, as distinguished from the Fisher system composition of an email message to a customer, Claim 1, for example,

recites "...receiv[ing] ... a request input by a user for an electronic mail delivery notification service by a carrier system for shipping a particular parcel ..." and then, "... for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, display[ing] ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications."

It is respectfully submitted that "... decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995). "Unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious or anticipated." *Id.*

In view of the holding of *In re Mahurkar*, in view of the actual limitations recited by Claims 1-6, 49-52 and 58, in view of the absence of any teaching or suggestion in *Nicholls* to "... automatically send delivery status messages over email ...," and in view of the absence of any disclosure in *Fisher* of email notification by carriers themselves, it is respectfully asserted, therefore, that neither *Fisher* nor *Nicholls* suggests the combination, and that the reasoning asserted by the Office Action for combining the two references is therefore unsupported.

**B. There is No Disclosure in Fisher of the Fisher Carriers Themselves Providing Delivery Notification or of any Monetary Distinction or Service Level Distinction, or of any Report or Display of any Monetary or Service Level Distinction, Between Charges or Service Levels Provided by one Fisher Carrier or Another for Providing Delivery Notification**

Yet further, for the following reasons and authorities, it is respectfully asserted that even when combined, the combination of *Nicholls* and *Fisher*

provide an insufficient foundation for rejection of Claims 1-6, 49-52 and 58 as required under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

In order to compensate for the above-quoted statement that "Nicholls ... fails to disclose the specific delivery requirements includes an electronic mail delivery notification ...," the Office Action states that "Fisher discloses a method for supplying automatic status updates using e-mail (See abstract) ..." and asserts that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as disclosed by Fisher ...." Office Action, Topic No. 8, p. 3. The Office Action further asserts that the aforementioned combination "... would have been obvious ... in order to automatically send delivery status messages over email without the aid or need of a human customer service representative [citing Fisher, cols. 1 and 2]." Office Action, Topic No. 8, p. 3.

As previously mentioned above, it is respectfully submitted that there is no disclosure in Fisher of the Fisher carriers themselves providing any type of delivery notification. Rather, in Fisher, as further explained below, it is the Fisher system that interrogates a carrier's system to determine the status of a customer's respective shipment; it is the Fisher system that then composes an email messages to the respective customer regarding the status of the customer's respective shipment.

Fisher discloses a merchant system that tracks shipment status of a customer's order sent by a particular merchant using a particular carrier to the respective ordering customer. According to Fisher, the Fisher system interrogates the carrier's system to determine the shipping status of the respective order. The Fisher system then composes and sends an email notice to the respective ordering customer regarding their respective order shipment status. Fisher, col. 2, lines 12 – 18.

As compared to a system such as disclosed in Fisher that itself composes a shipment status email message based on a carrier-system interrogation, it is



respectfully asserted that Claim 1, for example, recites limitations that "... for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel ... display ... a simultaneous identification of *shipping charges* for each delivery service offered by the respective carrier *to ship the particular parcel* according to the parcel shipping specifications..." (emphasis added). See also, Claims 28 and 49. That is, as compared to the Fisher system that itself provides shipment status, Claim 1, for example, is directed to providing a simultaneous display of shipping charges for various carriers and various delivery services that would provide delivery notification for shipping a parcel.

Moreover, it is respectfully submitted that there is no disclosure in Fisher of any monetary distinction or service level distinction, or of any report or display of any monetary or service level distinction, between shipping charges or service levels provided by one Fisher carrier or another for providing one type or another of delivery notification.

For reasons similar to those described above regarding Claims 1 and 49, it is respectfully submitted that Fisher does not disclose "... display[ing] to a display device configured for communication with a user client computer device associated with the at least one respective user, a simultaneous identification of each service-specific, carrier-specific delivery notification service charge ..." as recited by amended Claim 50.

For reasons similar to those described above regarding Claims 1, 28 and 49, it is respectfully submitted that Fisher does not disclose "...simultaneously displaying ... service-specific shipping charges ..." for multiple delivery services offered by multiple carriers as claimed by Claim 58.

As compared to a system such as disclosed in Fisher that itself composes a shipment status email message based on a carrier-system interrogation, it is respectfully asserted that Claim 51, for example, recites limitations for "... simultaneously identify[ing] to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a

respective parcel, each delivery service offered by each respective carrier of a plurality of carriers that would support each delivery notification service option requested by the respective user for delivery of the respective parcel....” That is, as compared to the Fisher system that itself provides shipment status, Claim 51, for example, is directed to providing a simultaneous identification of “... each delivery service offered by each respective carrier of a plurality of carriers that would support each delivery notification service option requested by the respective user for delivery of the respective parcel....”

For reasons similar to those described above regarding Claim 51, it is respectfully submitted that Fisher does not disclose “... displaying to a respective user of a plurality of users, in response to the respective user’s request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, a simultaneous identification of each delivery service offered by each respective carrier of a plurality of carriers that would provide the delivery notification service options requested by the respective user for shipping the respective parcel...” as recited by amended Claim 52.

Further, Claim 1 (*cf. also*, Claims 28 and 49), for example, recites that “... a request input by a user ...” is “... for an electronic mail delivery notification service by a *carrier system* ...” (emphasis added) as compared to an electronic mail delivery notification service *by the claimed system*. That is, as compared to a system as in Fisher that discloses *providing* electronic mail delivery notification, e.g., amended Claim 1 recites “... a request input by a user for an electronic mail delivery notification service *by a carrier system* for shipping a particular parcel ...”.

It is respectfully asserted, for the reasons described above, that Fisher whether considered alone or in combination with any other reference of record, does not anticipate, disclose, teach or suggest all of the limitations of the amended Claims of the present application.

**C. There is No Disclosure in Pauly of Pauly Carriers Themselves Providing Delivery Notification or of any Monetary Distinction or Service Level Distinction, or of any Report or Display of any Monetary or Service Level Distinction, Between Charges or Service Levels Provided by one Pauly Carrier or Another for Providing Delivery Notification**

Similar to the reasons given above with respect to Fisher, Applicants respectfully disagree that the Office Action presents a proper foundation for combining Pauly with Nicholls. More specifically, it is respectfully asserted that there is an insufficient foundation for rejection of Claims 28-33 as required under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

Similar to the rejections of Claims 1-6, 49-52 and 58 in view of Nicholls and Fisher, it is respectfully asserted that the assertions made in the Office Action regarding the rejection of Claims 28-33 in view of Nicholls and Pauly do not reflect the limitations recited by Claims 28-33.

For example, the Office Action states that “Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A) ....” Office Action, Topic No. 17, p. 6.

Applicants respectfully disagree that the statement in the Office Action that “Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A) ....” (Office Action, Topic No. 17, p. 6) fully reflects the limitations of Claims 28-33. For example, Claim 28 recites the limitations that “...for each respective carrier of the plurality of carriers *that would provide verbal delivery notification for shipping the particular parcel* according to the request, display ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.” (Emphasis added).

As compared to the above-recited limitations of Claim 28, it is respectfully submitted that none of the cited references, including Nicholls, disclose any variation in carrier-support of Proof of Delivery. That is, it is respectfully

submitted that none of the cited references, including Nicholls, disclose that some carriers may provide Proof of Delivery and that some carriers may not. Rather, it is respectfully asserted that it appears that the cited references, including Nicholls, assume that all carriers provide Proof of Delivery. It is respectfully asserted that it appears that if a user, in addition to entering other shipping information, designated the "Proof of Delivery" option in the Nicholls FIG. 4A, the Nicholls system would calculate a rate that would include any charge by a carrier for the requested "Proof of Delivery" option. However, it is respectfully submitted that there is no disclosure in Nicholls, that the Nicholls system would test whether a carrier would, or would not, provide the "Proof of Delivery" option.

As compared to the apparent assumption by Nicholls that all carriers provide the "Proof of Delivery" service, the Specification of the present application explains:

Another of the problems in dealing with standalone Carrier systems is that, if the Shipper wants verbal notification that a particular parcel has been delivered, the Shipper must attempt to apply each Carrier's rules for providing a Shipper with verbal notification that a particular parcel has been delivered. Each Carrier's verbal delivery notification pricing rules must be separately applied by the Shipper to shipment of a particular parcel to determine whether or not the particular Carrier offers verbal delivery notification and if so, the price for the service.

Specification, p. 2, line 29 – p. 3, line 5. It is respectfully asserted that, for example, Claim 28 recites limitations that reflect the above-mentioned disclosure of the specification. More specifically, for example, Claim 28 recites the limitations that "...for each respective carrier of the plurality of carriers *that would provide verbal delivery notification for shipping the particular parcel* according to the request,...." (Emphasis added).

Even so, independent Claim 28 has been amended to more distinctly recite a determination of whether each carrier provides verbal delivery notification. More specifically, Claim 28 has been amended to recite the limitation "... for each respective carrier of a plurality of carriers, determine whether the respective carrier would provide verbal delivery notification for

shipping the particular parcel according to the request ....”

The Office Action further states that “Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to specifically disclose the proof of delivery is a verbal communication of delivery status....” Office Action, Topic No. 17, p. 6. In order to compensate for the above-quoted statement that “Nicholls ... fails to specifically disclose the proof of delivery is a verbal communication of delivery status....,” the Office Action states that “Pauley discloses the use of customer service representatives which provide verbal communication of delivery status ...” and asserts that “[i]t would have been obvious ... to have the proof of delivery of Nicholls be the notification by the customer service representative, as disclosed by Pauley ....” Office Action, Topic No. 17, p. 6. The Office Action further asserts that the aforementioned combination “... would have been obvious ... in order to allow users to obtain delivery information without the use of a computer [citing Pauly, cols. 2 and 4].” Office Action, Topic No. 17, p. 6.

As opposed to the above-quoted statement in the Office Action that “Pauley discloses the use of customer service representatives which provide verbal communication of delivery status ....,” it is respectfully submitted that the limitations claimed by Claims 28-33 are not directed to supplying, or in any way providing, verbal communication of delivery status. Rather, Claim 28, for example, recites limitations to “... receive ... a request input by a user for a verbal delivery notification service by a carrier for shipping a particular parcel and an input by the user of parcel specifications for the particular parcel;... and for each respective carrier of the plurality of carriers that would provide verbal delivery notification for shipping the particular parcel according to the request, display ... a simultaneous identification of *shipping charges* for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.” That is, as compared to the assertion by the Office Action that Pauly “... discloses the use of customer service representatives which provide verbal communication of delivery status...”, Claim 28, for example, is directed to providing a simultaneous display of *shipping*

*charges* for various carriers and various delivery services that would provide verbal delivery notification for shipping a parcel.

For the foregoing reasons and authorities, it is respectfully asserted that the combination of Pauly with Nicholls asserted in the Office Action is based on an improper foundation that fails to accurately reflect the claimed limitations of Claims 28-33. Accordingly, it is respectfully asserted that there is an insufficient foundation for rejection of Claims 28-33 as required under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

Yet further, for the following reasons and authorities, it is respectfully asserted that the Office Action offers no evidence to support the asserted combination of Nicholls and Pauly. It is therefore respectfully asserted that the Office Action provides insufficient evidence of the asserted obviousness to make the asserted combination of Nicholls and Pauly.

The Office Action states that “Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to specifically disclose the proof of delivery is a verbal communication of delivery status...” (Office Action, Topic No. 17, p. 6) and then cites Pauly itself to assert that the combination of Pauly with Nicholls “... would have been obvious ... in order to allow users to obtain delivery information without the use of a computer [citing Pauly, cols. 2 and 4].” Office Action, Topic No. 17, p. 6.

For the following reasons and authorities, it is respectfully asserted that the Office Action's citation to Pauly alone provides insufficient basis to combine a feature of Pauly posited by the Office Action with Nicholls.

First, as compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination “...in order to allow users to obtain delivery information without the use of a computer ...,” it is respectfully submitted that none of Claims 28-33 are directed to supplying, or in any way providing, delivery information without the use of a computer. Rather, Claim 28, for example, recites limitations to “... receive ... a request input by a user for a

verbal delivery notification service by a carrier for shipping a particular parcel and an input by the user of parcel specifications for the particular parcel; ... and for each respective carrier of the plurality of carriers that would provide verbal delivery notification for shipping the particular parcel according to the request, display ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.” That is, as compared to the assertion by the Office Action that it would have been obvious to make the asserted combination “...in order to allow users to obtain delivery information without the use of a computer ...”, Claim 28, for example, is directed to providing a simultaneous display of *shipping charges* for various carriers and various delivery services that would provide verbal delivery notification for shipping a parcel.

Yet further, as compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination “...in order to allow users to obtain delivery information without the use of a computer ...”, it is respectfully submitted that Nicholls does not disclose “...obtain[ing] delivery information without the use of a computer ...”, and further does not disclose supplying, or in any way providing, verbal communication of delivery status.

Further still, as compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination “...in order to allow users to obtain delivery information without the use of a computer ...”, it is respectfully submitted that there is no disclosure in Pauly of *carriers themselves* providing any type of delivery notification or of any monetary distinction or service level distinction, or of any report or display of any monetary or service level distinction, between shipping charges or service levels provided by one carrier or another for providing one type or another of delivery notification.

Pauly is directed to a central ordering/inventory system for ongoing fulfillment of disposable contact lens prescriptions. See Pauly, Abstract. Pauly discloses shipping from the centralized inventory to the respective eye care professionals. See, e.g., Pauly, col. 3, lines 1-10.

As compared to the limitations of e.g., Claim 28 (see also, e.g., Claim 49)

for providing a "... display [of] ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications...", in Pauly, the Pauley system is "... [p]rogram[med] to allow customer service representatives to view orders already generated and learn the status of these orders, picked, shipped, etc. The representatives will also be able to confirm prescriptions as well as ship-to addresses." Pauly, col. 9, lines 34-38.

It is respectfully submitted that "... decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." In re Mahurkar Patent Litigation, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995). "Unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious or anticipated." Id.

In view of the holding of In re Mahurkar, in view of the actual limitations recited by Claims 28-33, in view of the absence of any teaching or suggestion in Nicholls to "... automatically send delivery status messages over email ...," and in view of the absence of any disclosure in Pauley of verbal notification by carriers themselves, it is respectfully asserted, therefore, that neither Pauley nor Nicholls suggests the combination, and that the reasoning asserted by the Office Action for combining the two references is therefore unsupported.

**D. There is No Disclosure in Kara, Nicholls or Thiel of a Simultaneous Identification of Shipping Charges for Each Delivery Service of Each Carrier and the Asserted Obviousness is Not Supported by Evidence but Rather is Based on Use of the Present Invention as a Roadmap to Combine Disparate Features of Separate References**

It is further respectfully asserted that, as described further below, in view of the concession by the Office Action that the cited references fail to disclose, teach or suggest simultaneous identification of shipping charges for each delivery



service of each carrier, the Office Action fails to support its conclusion of obviousness of the claimed limitations with evidence as required by MPEP §706.02(j) and MPEP §2143.

The Office Action states that “Fisher and Nichols discloses a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the automatic selection of a carrier and fails to disclose simultaneously displaying the rates of the carriers to the user.” Office Action, Topic No. 9, p. 4. See also, Office Action, Topic No. 18, p. 6.

In an effort to compensate for the above-quoted statement that “...Nicholls ... fails to disclose simultaneously displaying the rates of the carriers to the user...,” the Office Action asserts that “Kara discloses a computer program ... that simultaneously displays that [sic] calculate shipping rates of multiple carriers for multiple (first, second, third and fourth) services (See Figure 8, column 22, lines 20-38. Office Action, Topic No. 9, p. 4. See also, Office Action, Topic No. 18, p. 6.

Applicants respectfully disagree with the aforementioned characterization of Kara by the Office Action. As conceded by the Office Action in Topic 10, at page 4 (see also, e.g., Office Action, Topic No. 19, p. 6), it is respectfully submitted that Kara fails to disclose simultaneously displaying rates for multiple delivery services for multiple carriers. Yet further, it is respectfully submitted that Kara fails to disclose simultaneously calculating rates for multiple delivery services for multiple carriers.

The Office Action then concludes that “It would have been obvious ... to have the shipping rates of Nicholls displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22).” Office Action, Topic No. 9, p. 4. See also, Office Action, Topic No. 19, p. 6.

Applicant respectfully disagrees with the foregoing conclusion of the Office Action and respectfully submits that the Office Action fails to cite evidence of the

asserted obviousness. More specifically, the asserted evidence of obviousness of presenting a user with information for making an informed choice does not in any way teach or suggest the specific limitations of the rejected Claims.

The Office Action then states that "Nicholls, Fisher and Kara, disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of the rates for each carrier for each service." Office Action, Topic No. 9, Page 4. See also, Office Action, Topic No. 19, p. 6.

In an effort to compensate for the above-quoted statement that "Nicholls, Fisher and Kara ... fail[ ] to disclose the simultaneous display of the rates for each carrier for each service...", the Office Action asserts that "Thiel discloses the use of a system for calculating rates for multiple carriers for multiple services (see abstract), and discloses the computer storing data for the rates of each service for each carrier in one table (Column 11, lines 1-13). Thiel also discloses that the system will walk the user through which service is wanted, however, discloses displaying only the final rate for desired service for multiple carriers (Column 11, lines 46-54)." Office Action, Topic No. 10, Page 4. See also, Office Action, Topic No. 19, pgs. 6-7.

It is respectfully asserted that the above-quoted citation to the table of Thiel cited (at Thiel, col. 11, lines 1-13) by the Office Action does not support the assertion by the Office Action that "Thiel discloses ... the computer storing data for the rates of each service for each carrier (the "Thiel Table")".

In comparing the cited Thiel Table to both the features attributed to it in the Office Action, and more importantly, to the claimed limitations of the rejected Claims, it is respectfully asserted that the contents of the cited Thiel Table and the description by Thiel of the use of the cited Thiel Table as described by Thiel are instructive.

At first glance, the cited Thiel Table may appear to provide a stored shipping rate comparison. However, it is respectfully submitted that under close inspection, the cited Thiel Table provides a stored comparison of base rate

components, not of calculated shipping rates (as claimed by some of the rejected Claims).

More specifically, the cited Thiel Table is shown as containing shipping feature entries for five (5) different carriers. See Thiel, col. 11, lines 1-13. For each of the five (5) different carriers (Carrier 1-5), the cited Thiel Table shows a shipping feature entry for each of the following shipping features: Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt] Charge, Discount for greater than 100 items, Discount for greater than 1000 items, and Discount for greater than 10000 items. Id. at col. 11, lines 1-13.

As compared to *calculating rates* for multiple carriers for multiple services for a *simultaneous display* of rates for multiple services for multiple carriers (as is claimed in one way or another in some of the rejected Claims, it is respectfully submitted that Thiel describes the cited Thiel Table as a *stored* table of services and fee *components* of various carriers. Further, Thiel explains that the cited stored Thiel Table is used by the Thiel system to "... search[] the carriers which offer the desired services ..." (Thiel, col. 11, lines 22-23) and "... [perform] a fee optimization ... to reach the best price ..." (Thiel, col. 11, lines 29-30). That is, the cited Thiel Table is used by the Thiel system to identify carriers that would provide a user-pre-selected delivery service and user-requested shipping features and to calculate shipping rates for shipping a parcel; the cited Thiel Table does not contain calculated shipping rates for shipping a parcel.

In an effort to compensate for the above-quoted conclusion that "Thiel ... discloses displaying only the final rate for desired service for multiple carriers ...," the Office Action then asserts that even though "Nicholls, Kara and Theil [sic] fail to disclose the "simultaneous" display of shipping charges for each service of each carrier ...[, i]t would have been obvious ... to display all charges simultaneously." The Office Action reasons that "All the rates of each service of each carrier are calculated by Nicholls, Kara and Thiel. Thiel even shows all the rates are stored in one table, however, they all require some sort of selection by

the user before each charge is displayed.” Office Action, Topic No. 11, Pages 4-5.

Applicants respectfully disagree that the above-posed obviousness is properly supported by sufficient evidence as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143. Rather, it is respectfully asserted that the Office Action’s concession that a simultaneous display as claimed by the rejected Claims is completely absent from the references cited is strong evidence that such a simultaneous display is not obvious. *Cf., e.g., In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff’d*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995). “Unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious or anticipated.” *Id.*

Even after making the above-stated concessions of the complete absence of a simultaneous display as claimed in one way or another by Claims 1-6, 28-33, 49-52 and 58, in an effort to justify the rejection under Section 103(a), the Office Action nevertheless posits that “the way something is displayed, is not considered to be patentable over the prior art of record, therefore it would have been obvious ... to display all the calculated rates simultaneously for comparison purposes.” Office Action, Topic No. 11, Page 5.

The Office Action then concludes that “[i]t should also be noted that the claims are all drawn to system claims, which are limited to the actual systems and their capabilities, and that what information is actually displayed is considered to be printed matter, and unless the information is used further in the system, then what is actually displayed is considered non-functional.” Office Action, Topic No. 11, Page 5.

For the reasons and authorities given below, it is respectfully asserted that a printed matter rejection is misplaced.

First, with regard to the aforementioned “printed matter” rejection, as the Office Action admits, it is respectfully noted that the rejected claims are directed to computer systems. It is respectfully submitted that computer systems have been well established as being patentable subject matter under 101.

Further, "... when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, (United States Patent and Trademark Office; Official Gazette Notices for November 22, 2005), § II.C (citing Diamond v. Diehr, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) ("In determining the eligibility of respondents' claimed process for patent protection under Sec. 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made."))).

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. Gulack, 703 F.2d at 1385. The PTO may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384; see also Diamond v. Diehr, 450 U.S. 175, 191 (1981)." In re Lowry, 32 F.3d 1579, 1582, 32 USPQ2d 1031, \_\_\_ (Fed. Cir. 1994). Further, the In re Lowry court noted "... that Gulack cautioned against a liberal use of 'printed matter rejections' under section 103 ...." "A 'printed matter rejection' under [[section]] 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. . . . [The Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated." In re Lowry, 32 F.3d at 1583 (quoting Gulack, 703 F.2d at 1385 n.8).

For reasons similar to those given above with respect to Claims 1, 28, and 49, it is respectfully submitted that none of Kara, Nicholls or Thiel disclose

"...simultaneously displaying ... service-specific shipping charges ..." for multiple delivery services offered by multiple carriers as claimed by Claim 58.

For the reasons given and authorities cited above, it is respectfully asserted that none of Kara, Nicholls or Thiel, whether considered alone, or in combination with any other reference, anticipates, discloses, teaches or suggests all of the limitations of the amended Claims of the present application.

In view of the above-given reasons and authorities, it is respectfully asserted that the combination of limitations claimed by Claims 1-6, 28-33, 49-52 and 58 are non-obvious over the references of record.

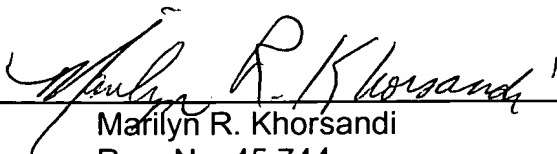
**CONCLUSION**

For the foregoing reasons and authorities, because, as respectfully asserted above, independent Claims 1, 28, 49-52, and 58 are patentable over the cited references, it is respectfully asserted that dependent Claims 2 through 6, and 29 through 33, are therefore also patentable over the cited references.

In view of the foregoing reasons and authorities, it is respectfully submitted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, it is respectfully requested that the present application be reconsidered and allowed.

Respectfully submitted,

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